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RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

8 Attorneys for Defendant
AuthenTec, Inc.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

12 ATTEL CORPORATION, a Delaware
corporation; ATTEL SWITZERLAND, a
13 corporation; ATTEL FRANCE, a corporation;
and ATTEL SARL, a corporation,

Case No. 06 CV 2138 CW

**REQUEST FOR INTERNATIONAL
JUDICIAL ASSISTANCE PURSUANT TO
THE HAGUE CONVENTION THE TAKING
OF EVIDENCE ABROAD IN CIVIL OR
COMMERCIAL MATTERS
(HAGUE CONVENTION #20)**

AUTHENTEC, INC., a Delaware corporation,
Defendant.

19 | IDENTITY AND ADDRESS OF THE APPLICANT:

Honorable Elizabeth Laporte
United States District Court for the Northern District of California
San Francisco Division
Courtroom E, 15th Floor
450 Golden Gate Avenue
San Francisco, CA 94102

CENTRAL AUTHORITY OF THE RECEIVING STATE:

M. Michel RISPE
Ministère de la Justice
Direction des Affaires Civiles et du Sceau
Bureau de l'entraide civile et commerciale internationale (D3)
13, Place Vendôme
75042 Paris Cedex 01
FRANCE
Téléphone: 33 (1) 44 77 66 34

1 In conformity with Article 3 of Hague Convention #20, the undersigned applicant has the honor
 2 and judicial authority to submit this request on behalf of the Defendants in the above-entitled action.

3 The United States District Court, for the Northern District of California, by and through the
 4 Honorable Elizabeth Laporte, presents its compliments to the judicial authorities of France, and
 5 requests international judicial assistance to obtain evidence to be used in a civil proceeding before this
 6 court in the above-captioned matter.

7 A trial on this matter is currently scheduled to take place in California. This court requests the
 8 assistance described herein as necessary in the interests of justice.

9 Below are the names of all parties in this matter and their representatives:

Party	Legal Representative
PLAINTIFFS: Atmel Corporation Atmel Switzerland Atmel France Atmel SARL By and through counsel: Denise McKenzie, Esq. Sidley Austin LLP 555 West Fifth Street, Suite 4000 Los Angeles, California 90013-1010 United States of America Telephone (213) 896-6000	Denise McKenzie, Esq. Sidley Austin LLP 555 West Fifth Street, Suite 4000 Los Angeles, California 90013-1010 United States of America Telephone (213) 896-6000
DEFENDANTS: AuthenTec, Inc. By and through counsel: Denise De Mory, Esq. Howrey LLP 525 Market Street, Suite 3600 San Francisco, California, 94105 United States of America Telephone (415) 848-4900	Henry C. Bunsow, Esq. Denise De Mory, Esq. Brian A.E. Smith, Esq. Howrey LLP 525 Market Street, Suite 3600 San Francisco, California, 94105 United States of America Telephone (415) 848-4900 Fax (415) 848-4999

22 **REPRESENTATIVE TO ACT ON BEHALF OF DEFENDANTS:**

23 It is requested that should contact or correspondence with Defendants in this matter be
 24 required, the following individual is appointed in this matter to represent Defendants:

25 Denise De Mory, Esq.
 26 Howrey LLP
 27 525 Market Street, Suite 3600
 28 San Francisco, California, 94105
 United States of America
 Telephone (415) 848-4900
 Fax (415) 848-4999

1 **ENTITY FROM WHOM EVIDENCE IS REQUESTED:**

2 **Thales S.A.**
 3 45 rue de Villiers
 4 92200 Neuilly-sur-Seine Cedex
 5 France

6 It is believed that **Thales S.A.** is a business entity registered to do business in France.

7 **SUBJECT MATTER AND RELATIVITY OF THIS REQUEST:**

8 Atmel filed a complaint against AuthenTec, Inc. (“AuthenTec”) in the United States District
 9 Court for the Northern District of California alleging patent infringement (“Atmel Lawsuit”). The two
 10 patents asserted against AuthenTec relate to fingerprint sensors. Based on documents that AuthenTec
 11 has received in this case, AuthenTec believes that the two patents asserted by Atmel may be invalid
 12 due to inventorship by another and/or an on sale bar. AuthenTec believes that evidence of prior
 13 inventorship and/or an on sale bar is in the possession, custody and control of **Thales S.A.**, in part,
 14 because Atmel has produced documents authored by the inventor of the asserted patents referencing
 15 **Thales S.A.** AuthenTec also believes that the inventor of the asserted patents was employed by a
 16 predecessor company to **Thales S.A.** The requested documents and information from **Thales S.A.** are
 therefore relevant to and necessary for trial of this case.

17 **SPECIFIC REQUESTS:**

18 The District Court respectfully requests that these documents and information be produced
 19 quickly, but if at all possible within 30 days after receipt of this request, at a place and time designated
 20 by the French court having competent jurisdiction over this request.

21 In view of the foregoing, we therefore request, in the interest of justice, that you issue an order
 22 for the acquisition of the evidence requested below, in accordance with the laws and procedures of the
 23 courts of France, and summon the appropriate employee, director, officer or other appropriate
 24 representative of **Thales S.A.**, in possession or control of the evidence requested, to submit the
 25 evidence requested to a duly appointed authority in France, in an expeditious manner, for examination
 26 by the below signed authority.

1 **EVIDENCE TO BE OBTAINED:**

2 **A. Definitions.**

3 In addition to the abbreviated terms identified above, for the purposes of this request:

4 (1) the terms “you” and “your” mean **Thales S.A.**, including, without limitation, all
 5 predecessors (merged, acquired, or otherwise), successors, subsidiaries, parents, sisters, partnerships
 6 and affiliates thereof, including but not limited to Thales Research & Technology, and all directors,
 7 officers, agents, employees, attorneys, and other persons acting on its behalf;

8 (2) the term “Thompson-CSF” means Thomson-CSF and all predecessors (merged, acquired, or
 9 otherwise) successors, subsidiaries, parents, sisters, partnerships and affiliates thereof, including but
 10 not limited to IDmatics, and Laboratoire Central de Recherches, and all directors, officers, agents,
 11 employees, attorneys, and other persons acting on their behalf;

12 (3) the term “Thomson-CSF Semiconducteurs Specifiques” means Thomson-CSF
 13 Semiconducteurs Specifiques, including but not limited to Atmel Grenoble, and all predecessors
 14 (merged, acquired, or otherwise), successors, subsidiaries, parents, sisters, partnerships and affiliates
 15 thereof, and all directors, officers, agents, employees, attorneys, and other persons acting on their
 16 behalf;

17 (4) the term “Atmel” means Atmel Corporation, Atmel SARL, Atmel France, Atmel
 18 Switzerland, Atmel Grenoble and all predecessors (merged, acquired, or otherwise), successors,
 19 subsidiaries, parents, sisters, partnerships and affiliates thereof, and all directors, officers, agents,
 20 employees, attorneys, and other persons acting on their behalf.

21 (5) the term “fingerprint sensor” means all mechanical, electronic, optical, electro-optical,
 22 capacitive, reflection, RF, pressure, temperature, ultrasound, and micro-electro-mechanical systems
 23 and devices designed to read a fingerprint for authenticating individuals, including but not limited to
 24 all prototypes and experiments related to such sensors and further including but not limited to strip
 25 and/or swipe sensors;

26 (6) the term “fingerprint sensing technologies” means all hardware, software, and other
 27 components that may be incorporated into or work in conjunction with a fingerprint sensor, including
 28 but not limited to electronic circuitry, microchips, elements, conductive layers, and algorithms further

1 including but not limited to image stitching algorithms;

2 (7) the word "document" includes any written, printed, typed, recorded, computerized,
 3 electronic, taped, graphic, or other matter, in whatever form, whether in final or draft, including but not
 4 limited to all materials that constitute "writings," "recordings," "photographs," "source code" or
 5 "executable code" within the broadest meaning of Rule 1001 of the Federal Rules of Evidence and all
 6 materials that constitute "documents" within the broadest meaning of Rule 34 of the Federal Rules of
 7 Civil Procedure. The word "document" includes, without limitation, printed matter, electronic mail,
 8 materials stored on computer hard drives, diskettes, tapes, any other computer media, and any other
 9 information stored magnetically, optically or in any electronic medium and/or form; and

10 (8) the term "communication" includes, without limitation, communications by whatever
 11 means transmitted (i.e., whether oral, written, electronic or other methods used), as well as any note,
 12 memorandum or other record thereof.

13 (9) the term "FingerChip" means the fingerprint sensor manufactured by the Atmel
 14 Corporation, including but not limited to the fingerprint sensing technologies developed by Jean-
 15 Francois Mainguet and incorporated into the FingerChip product.

16 **B. Documents requested.**

17 The District Court requests the production of the following documents, which are in the
 18 possession, custody, or control of **Thales S.A.**:

19 1. Documents relating to or referring to United States Patent No. 6,289,114 ("the '114 patent)
 20 or United States Patent No. 6,459,804 ("the '804 patent") titled "Fingerprint-Reading System."

21 2. Documents relating to or referring to any communications you had with any person
 22 concerning assignment of any rights in the '804 patent and/or '114 patent.

23 3. Documents relating to or referring to any sublicense granted by you, Thomson-CSF, or
 24 Thomson-CSF Semiconductuers Specifiques, conferring any rights in the '804 patent and/or '114
 25 patent.

26 4. All documents constituting, referring, or relating to any draft or actual agreements, including
 27 but not limited to licensing, between you, Thomson-CSF, or Thomson-CSF Semiconductuers
 28 Specifiques, and/or any third party(ies) that refer or relate to the '804 patent and/or the '114 patent

1 and/or any Thomson-CSF patent that is or could be used by fingerprint sensor products, including but
 2 not limited to agreements relating to fingerprint sensing technologies.

3 5. Documents relating to or referring to fingerprint sensors and/or fingerprint sensing
 4 technologies consisting of: (1) sensors with a surface area smaller than the surface area of a finger,
 5 and/or (2) combining partial fingerprint images to create a more complete fingerprint image, and/or (3)
 6 collection of fingerprint data by movement of a finger over a fingerprint sensor, including but not
 7 limited to publications, articles, patents, patent applications, schematics, lab notebooks, and manuals.

8 6. Documents relating to or referring to communications prior to June 5, 1997 between you
 9 and Jean-Francois Mainguet, or any other person employed by or associated with Thomson-CSF
 10 and/or Thomson-CSF Semiconductuers Specifiques, concerning fingerprint sensors and fingerprint
 11 sensing technologies, including but not limited to FingerChip.

12 7. Documents relating to or referring to communications between you and Thomson-CSF,
 13 Thomson-CSF Semiconductuers Specifiques, and/or Atmel concerning licensing, offers to license,
 14 infringement, invalidity and/or that affect in any way rights related to the '804 patent and/or the '114
 15 patent.

16 8. Documents relating to or referring to communications evidencing existence of an attorney-
 17 client relationship and/or privilege between you and Atmel.

18 9. Documents evidencing any rights you have in the '804 patent and/or '114 patent.

19 10. Documents relating to or referring to communications between you and Atmel concerning
 20 fingerprint sensors and fingerprint sensing technologies.

21 The documents and information requested above are for use as evidence in the Atmel Lawsuit,
 22 including for use at trial. This Court makes this request to secure production of documents and
 23 information from **Thales S.A.**, which resides in the jurisdiction of France, and this Court confirms that
 24 this is proper and necessary to request since it relates to AuthenTec's counterclaims and defenses and
 25 is necessary for a fair resolution of issues at trial.

26 It is requested that should any portion of this request, or subject questions as described below,
 27 be denied on legal grounds, that such denial not affect the remainder of this request.

28

HOWREY LLP

Request for International Judicial Assistance Pursuant to Hague Convention #20
 Case No. 06 CV 2138 CW
Thales S.A. - FRANCE

1 It is requested that any evidence produced be marked, attested, properly sealed by the
2 appropriate authorities of France and returned through appropriate channels to the below signed
3 authority

4 Defendant AuthenTec, through counsel Howrey LLP (525 Market Street, Suite 3600, San
5 Francisco, California 91405, United States of America, Telephone: (415) 848-4900), will reimburse
6 the appropriate judicial authorities in France, for all costs incurred in executing the below signed
7 judicial authority's request for international judicial assistance.

8 When required, the below signed judicial authority shall provide reciprocal assistance, such as
9 requested herein, to the appropriate judicial authorities of France.

10 The United States District Court for the Northern District of California extends the assurance of
11 its highest consideration to the judicial authorities of France.

12 Date of Request: Sept 17, 2007.

13 By:

14 
15 HON. ELIZABETH LAPORTE
16 UNITED STATES DISTRICT COURT JUDGE
17 United States District Court
18 Northern District of California
19 San Francisco Division
20 Courtroom E, 15th Floor
21 450 Golden Gate Avenue
22 San Francisco, CA 94102

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